REMARKS/ARGUMENTS

Applicant greatly appreciates the further explanation of the Examiner's interpretation of prior art given by Examiner Hylton during the telephonic interview held on January 5, 2009. The subject matter discussed during the interview is incorporated in the discussion below.

Claims 1, 2, 4-9, 11-15, and 17-22 are pending in this application, with claims 1, 5, 11, and 14 being the only independent claims. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Rejection over Berger and Klundt

Claims 1, 2, 4-9, 11-15, and 17-22 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 5,992,658 (Berger) in view of U.S. Patent No. 6,763,681 (Klundt).

Independent claim 1 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said at least one turn extends spirally around said straw support portion, said at least one turn having an inner edge with an inner radius and an outer edge with an outer radius wherein said inner and outer radii increase substantially continuously around said at least one turn."

The Examiner acknowledges that Berger fails to teach or suggest a spirally extending bottle retaining portion.

Klundt fails to teach or suggest what Berger lacks. Klundt discloses a combination ring and object holder with an integral spring. According to Klundt, the combination ring and holder 10 includes a ring 12 with a flat upper surface 14 to which one end of a spring 16 is secured (see col. 2, lines 14-17; and Figs. 1-3 of Klundt). A coupling member 18 is secured to an opposite end of the spring 16 and retains an object 19 thereon (col. 2, lines 35-42).

In the present rejection, the Examiner alleges that the combination of elements from Berger and Klundt teaches or suggests the claimed invention. MPEP 2143, citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007), instructs that to support such a rationale, certain points must be articulated, one of which is "(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately."

The spring of Klundt is connected between two pieces of the overall device, i.e., the combination of ring and holder 10. More specifically, one end of the spring 16 is connected to the holder portion 18 the other end of the spring 16 is connected to the upper surface 14 of the ring 12. Thus, the spring 16 is meant to be attached to a retaining device (ring 12) and can not be considered to be a retaining device itself. Klundt expressly teaches that the spring is always meant to be used with the ring and object holder (see col. 1, lines 28-31 of Klundt). Thus, the use of the spring in the Examiner's proposed combination performs a different function than that of the spring in Klundt. Since the ring in Klundt is used to mount or retain the overall device to an external support, and the spring is held by the ring, the combination alleged by the Examiner would not yield predictable results to those of ordinary skill in the art.

During the above-referenced telephone conversation, the Examiner indicated that a spring could be used to fit on a bottle which was sized to fit in the spring. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless **>the results would have been predictable to one of ordinary skill in the art.

KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) (*see* MPEP 2143.01). As stated above, Klundt teaches that the ring is used to mount the device to a support, and the spring is used as a novelty to connect the support to the ring. Thus, Klundt fails to teach or suggest the claimed bottle retaining portion.

In addition, the spring of Klundt fails to teach or suggest "wherein said inner and outer radii increase substantially continuously around said at least one turn", as expressly recited in independent claim 1. In contrast, the spring of Klundt has a contant radius. Accordingly, independent claim 1 is allowable over Berger and Klundt for at least this additional reason.

For all the above reasons, independent claim 1 is allowable over Berger in view of Klundt.

Independent claim 5 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said at least one turn extends circularly about said straw support portion from said first end to a second end, said at least one turn having an inner edge with an inner radius and an outer edge with an outer radius wherein said inner and outer radii are substantially constant around said at least one turn, said retaining portion further comprising a radial connecting portion connected to said inner edge at said first end of said first turn and to a radially outer edge of straw support portion and connecting said first end of said first turn to said straw support portion."

First, the combination of Berger and Klundt fails to disclose the bottle retaining portion of claim 5 because it is not a predictable result to one skilled in the art that the spring of Klundt could be used as a bottle retaining portion, as described in detail above.

In addition, independent claim 5 further recites "a radial connecting portion connected to said inner edge at said first end of said first turn and to a radially outer edge of straw support portion and connecting said first end of said first turn to said straw support portion." Klundt discloses that the end of the spring is either glued to holder 18 or threaded into an opening (see col. 2, lines 56-62 of Klundt). Thus, Klundt fails to teach or suggest a radial connecting portion.

For all of the above reasons, independent claim 5 is allowable over Berger in view of Klundt.

Independent claim 11 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said straw support portion and said bottle retaining portion are integrally formed of said sheet material and said straw holder has a central axis perpendicular to said sheet and passing through said aperture, said straw holder exhibiting both axial and radial elasticity relative to said axis, said axial elasticity being substantially greater than said radial elasticity."

First, the combination of Berger and Klundt fails to disclose the bottle retaining portion of claim 11 because it is not a predictable result to one skilled in the art that the spring of Klundt could be used as a bottle retaining portion, as described in detail above with respect to independent claim 1.

In addition, independent claim 11 further recites "wherein said straw support portion and said bottle retaining portion are integrally formed of said sheet material." There is simply no way, that the spring of Klundt can be considered to be formed of a sheet material.

For all of the above reasons, independent claim 11 is allowable over Berger in view of Klundt.

Independent claim 14 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle" and "adhesive disposed on one side of the straw support portion that contacts the mouth of the bottle."

The combination of Berger and Klundt fails to disclose the bottle retaining portion of claim 14 because it is not a predictable result to one skilled in the art that the spring of Klundt could be used as a bottle retaining portion, as described in detail above with respect to independent claim 1.

Rejection over Berger and Marshall

Claims 1, 2, 4-9, 11-15, and 17-22 stand rejected under 35 U.S.C. §103 as unpatentable over Berger in view of U.S. Published Patent Application No. 2005/0029270 (Marshall).

Independent claim 1 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said at least one turn extends spirally around said straw support portion, said at least one turn having an inner edge with an inner radius and an outer edge with an outer radius wherein said inner and outer radii increase substantially continuously around said at least one turn."

The Examiner acknowledges that Berger fails to teach or suggest a spirally extending bottle retaining portion.

Marshall fails to teach or suggest what Berger lacks. Marshall relates to a straw-insertable reusable drinking container seal. Fig. 1A of Marshall discloses an extended disk-like body 2 holding a straw in a bottle 10. The disk-like body 2 is connected to an inside of a cap 1 of the bottle. As indicated by the Examiner, a spirally extending portion may be attached to the disk-like body as shown in Fig. 5. The spiral extending portion is disclosed as being coiled inside a bottle cap.

As stated above, an obviousness rejection made by combining elements requires a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately (see MPEP 2143). In Marshall, the spiral extending portion is used to connect the straw holder portion or disk-like body 2 to the cap 1. That is, the spiral extending portion is used as a tether between the disk-like body 2 and the cap 1. Since the spiral extending portion in Marshall is used to connect the disk-like body 2 to the bottle cap 1, one skilled in the art would not consider the spiral extending portion to be a bottle retainer. Accordingly, the combination alleged by the Examiner would not yield predictable results to those of ordinary skill in the art.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless **>the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) (*see* MPEP 2143.01). The Examiner states that a smaller bottle would fit into the spiral extending portion. However, Marshall discloses only that the spiral portion allows the disk-like body to remain connected to a straw while the cap is placed on the bottle top. Accordingly, there is no teaching or suggestion that the spiral extending portion could function as a bottle retaining portion.

For all of the above reasons, independent claim 1 is allowable over Berger in view of Marshall.

Independent claim 5 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said at least one turn extends circularly about said straw support portion from said first end to a second end, said at least one turn having an inner edge with an inner radius and an outer edge with an outer radius wherein said inner and outer radii are substantially constant around said at least one turn, said retaining portion further comprising a radial connecting portion connected to said inner edge at said first end of said first turn and to a radially outer edge of straw support portion and connecting said first end of said first turn to said straw support portion."

The combination of Berger and Marshall fails to disclose the bottle retaining portion of claim 5 because it is not a predictable result to one skilled in the art that the spiral extending portion of Marshall could be used as a bottle retaining portion, as described in detail above.

Independent claim 11 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said straw support portion and said bottle retaining portion are integrally formed of said sheet material and said straw holder has a central axis perpendicular to said sheet and passing through said aperture, said straw holder exhibiting both axial and radial elasticity relative to said axis, said axial elasticity being substantially greater than said radial elasticity."

The combination of Berger and Marshall fails to disclose the bottle retaining portion of claim 11 because it is not a predictable result to one skilled in the art that the spiral extending portion of Marshall could be used as a bottle retaining portion, as described in detail above with respect to independent claim 1.

Independent claim 14 recites "a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle" and "adhesive disposed on one side of the straw support portion that contacts the mouth of the bottle."

The combination of Berger and Marshall fails to disclose the bottle retaining portion of claim 14 because it is not a predictable result to one skilled in the art that the spiral extending portion of Marshall could be used as a bottle retaining portion, as described in detail above with respect to independent claim 1.

Furthermore, Marshall fails to disclose, teach or suggest an adhesive as recited in claim 14 because the disk-like body 2 of Marshall is designed to be inside the bottle.

Accordingly, independent claim 14 is allowable over Berger in view of Marshall.

Dependent claims 2, 4, 6-9, 12-15, and 17-22 are allowable for at least the same reasons as are independent claims 1, 5, 11, and 14, as well as for the additional recitations contained therein.

In view of the above remarks, the application is deemed to be in condition for allowance and notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Should the Examiner have any comments, questions, suggestion , or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

Respectfully submitted,
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